

REMARKS

Applicants respectfully request reconsideration of the application in view of the foregoing amendments and the following remarks.

Claims 4, 11-17, and 20 are currently pending.

The allowance of claims 4, 11-17 and 20 is noted with appreciation.

Claims 15-16 are amended herein to more particularly point out and distinctly claim the subject matter of Applicants invention. Support for the amendments can be found, *inter alia*, in the Specification at page 13, lines 24-31. No new matter has been added.

Oath/Declaration

The application is objected to because the oath or declaration fails to identify the priority applications in accordance with 37 C.F.R. § 1.67(a). In response thereto, Applicants submit herewith a new signed declaration that complies with the rules set forth in 37 C.F.R. § 1.67(a) and MPEP §§ 602.01 and 602.02. The new declaration properly claims benefit to the priority applications 08/408,669, filed March 22, 1995 and 08/409,122, filed March 22, 1995.

Rejections under 35 U.S.C. § 112, Paragraph 2

Claims 15, 16, and 17 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. Specifically, the Office Action mailed December 4, 2003, states that recitation of the term “comprising” renders the claims confusing because the term “comprising” indicates that more than one element should be present. The Office Action further states that since only one element is defined in claims 15-17, it is not clear what other element is intended to be present. Applicants respectfully traverse the grounds for rejection, but herein amend the claims to advance prosecution of the case.

Applicants’ previous response, filed March 4, 2004, requested that the Office set forth the specific statutory authority or regulation that mandates that use of the term “comprising” requires that more than one element be part of the claim. In response thereto, the outstanding Office Action, mailed April 7, 2004, indicates that “the authority for what Office stated comes from the statutory language, which recites the claims, should ‘particularly point out and distinctly claim the subject matter.’” *See* Office Action at page 2.

Applicants maintain their position that the term “comprising” does not necessarily require that more than one element be present in the claim and that claims 15-16 should be

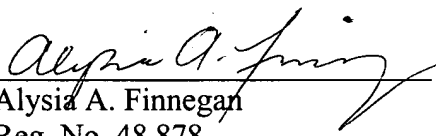
allowable as written. However, without acquiescing to the grounds of rejection set forth in the Office Action mailed December 4, 2003, Applicants herein amend claims 15 and 16 in an effort to advance prosecution on the merits, without prejudice to pursuing the subject matter in a separate continuation application. More specifically, Applicants have amended the claims to require a "pharmaceutically acceptable carrier," as suggested by the Examiner.

Applicants respectfully assert that the boundaries of claims 15-17 are discernable from the text of the amended claims. Accordingly, Applicants submit that claims 15-17 are in condition for allowance and respectfully request that the rejection of these claims under 35 U.S.C. § 112, second paragraph be removed and the claims allowed.

Summary

Applicants respectfully submit that all claims are in condition for allowance and a favorable action on the merits is earnestly solicited. The Examiner is invited to contact the undersigned attorney at the telephone number provided below if such would advance the prosecution of the case.

Respectfully submitted,

By 
Alysia A. Finnegan
Reg. No. 48,878
Attorney for Applicant

MERCK & CO., INC.
P.O. Box 2000
Rahway, New Jersey 07065-0907
(732) 594-2583

Date: July 7, 2004